



PATENT

Customer Number 22,852  
Attorney Docket No. 4121.0165-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ronda M. Allen et al.

Serial No.: 09/648,641

Filed: August 25, 2000

For: METHODS FOR PURIFYING  
DNA POLYMERASES

)  
)  
) Group Art Unit: 1654  
)  
) Examiner: M. MELLER  
)  
)  
)  
)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RECEIVED

MAY 08 2003

TECH CENTER 1600/2900

Sir:

RESPONSE

Applicants now respond to the Office Action mailed April 8, 2003. Applicants thank the Examiner for the courtesies extended to the undersigned during his telephone conversations on April 30 and May 2, 2003.

The Examiner requires an election under 35 U.S.C. § 121. See Office Action, page 2. Specifically, the Examiner alleges that the Response filed January 10, 2003, was not fully responsive to the prior Office Action.

Applicants respectfully disagree with the Examiner. In the prior Office Action the Examiner failed to clearly identify each of the disclosed species to which the claims are restricted. When making an election requirement, the Examiner should "[c]learly identify each (or in aggravated cases at least exemplary ones) of the disclosed species *to which claims are restricted*. ... In the absence of distinct figures or examples to identify the

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

several species ... or other distinguishing characteristic[s] of the species should be stated for each species identified. If the species *cannot be conveniently identified*, the claims may be grouped in accordance with the species to which they are restricted." Manual of Patent Examining Procedure ("MPEP") §809.02(a) (B) (emphasis in original).

The Examiner failed to identify even a single species.

The Examiner also incorrectly placed the burden of identifying species on the Applicants, stating that "applicant is required to enumerate all of the components to be used in the elected invention." Office Action, September 10, 2002, page 2, third paragraph.

Further, the Examiner failed in this Office Action, as well as the previous, to explain why an election requirement is required. "Where the related inventions as claimed are shown to be distinct under the criteria of MPEP §806.05(c) - §806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation..." that there is (a) a separate classification for each invention, (b) a separate status in the art when [the inventions] are classifiable together, or (c) that the different inventions require a different field of search. MPEP §808.02. The Examiner has again failed to provide any appropriate explanation for any of these reasons for requiring an election requirement. Thus, the applicants traverse the election requirement.

The Examiner appears to suggest that the Applicants must elect which prior chromatography is used, as enumerated in claims 4-9. Further, the Examiner implies, but does not explicitly state, that the Applicants need to "elect an enzyme from claims 16-18." Office Action, page 2.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

The Examiner appears to require an election of a prior chromatography step used. Claim 1 does NOT require that a prior chromatography step occur. Use of prior chromatography is introduced in dependent claim 3. The Applicants would like to elect the species wherein there is no prior chromatography before fractionating the sample using Poly U Sepharose chromatography. Claims 1, 2, and 10- 18 are readable thereon. This invention is within the scope of claim 1, but not included in the Examiner's election requirement.

However, in order to prevent the Examiner from erroneously finding this paper non-responsive, if the Examiner does not accept the Applicants' election, Applicants' second election is a prior chromatography wherein the prior chromatography is hydrophobic chromatography. This election does not preclude additional prior chromatography in addition to the hydrophobic chromatography. Claims 1, 3, 4, and 10-19 are readable thereon.

The Examiner also appears to require the election of one of the enzymes of claims 16-18. Applicants elect an archaeobacterial DNA polymerase, as enumerated in claim 16. Claims 1-19 are readable thereon.

Furthermore, Applicants traverse the requirement because the **Examiner has again failed** to established that it would be an undue burden to examine claims 1 and 19, the claims the Examiner stated are generic, and from which all other claims ultimately depend. See MPEP § 803.

Applicants respectfully remind the Examiner that, in the event that the elected species is found allowable, the Examiner is required to examine the claims with respect to the non-elected species. See MPEP §809.02(c)(B)(1).


In the event the Examiner has any questions concerning this response, Applicants request that the Examiner contact the undersigned at (650) 849-6676, and respectfully request that the Examiner set forth a proper election requirement and enumerate species suitable for election.

If there is any fee due in connection with the filing of this Response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: May 6, 2003

By:   
Robert W. Mann  
Reg. No. 48,555

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com